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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/845,362
Filing Date: April 30, 2001
Appellant(s): HAYNES ET AL.

Jack P.Friedman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/13/2005.

(1)   Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2)   Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly

affect or be directly affected by or have a bearing on the decision in the pending appeal

is contained in the brief.

(3)   Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4)   Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5)   Summary of Invention

The summary of invention contained in the brief is correct.

(6)   Issues

The appellant's statement of the issues in the brief is correct.

(8)   Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   Prior Art of Record

6,167,383	HENSON	12-2000
6,711,619	CHANDRAMOHAN ET AL.	3-2004

(10)   Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1-4, 14-22 and 24-28 are rejected under 35 U.S.C. 102 (e). This rejection

is set forth in a prior Office Action, mailed on 1/11/2005 and reproduced below:

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 14-22 and 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson et al. (US Patent 6,167,383), hereinafter referred to Henson.

Regarding claim 1, Henson teaches a method for managing An electronic commerce (e-commerce) shopping cart relating to communication between a shopper and a server over a communication network, said method (see at least col.1, lines 53-66, " *Referring now to FIG.1, the present implementation of an online store 10 for use in generating customer configured machines.......The commerce application 14 includes a configurator 18, shopping cart 20,...* ", and col.9, lines 26-29, " *In accordance with another aspect of the online store, the shopping cart is customized with merchandising options. The cart takes on merchandising options similar to what the configurator is doing.* "), comprising the steps of:
determining by the server whether a shopping command of the shopper has changed an attribute of a primary item in the shopping cart, after the server has determined that the shopping command has changed an attribute of the primary item in the shopping cart, identifying by the server a secondary item in the shopping cart linked to the primary item, and changing by the server a corresponding attribute of the secondary item in response to the change in the attribute of the primary item (see col.15, lines 31-45, " *Everything in the configurator is specific to a given computer system (i.e., chassis) per customer or per set of customers. **The welcome page is geared towards identifying a chassis. Given the chassis, the configurator displays the universe or possible options within that chassis, for a given customer set.** Messaging has now been included in that option universe to assist a user in choosing a best selection for that user. **If a user decides upon a different chassis,** the user must return to the welcome page and select another chassis. The options within the configurator are dependent upon the chassis. If a user wants to go to a different universe, then the user must exit the configurator, go back to the welcome page, and select a new universe (i.e., a different chassis). Recommendations can include lead time warnings, as well as compatibility warnings.* ".Note: Henson, in this segment, discloses the functioning of the Validation module 34[FIGF.1]. The server is able to determine if the particular computer system, that is chassis [corresponds to the primary item as claimed in the application] and the options [correspond to secondary items as claimed in the applications] chosen for the system are consistent and if it is so determined that the computer system is changed

automatically the options for the new primary item, that is computer system are changed. Changing the computer system requirement by the user corresponds to the shopping command from the user for changing an attribute of the primary item [the computer system which the user wants to buy]. Therefore, Henson suggests that the attributes of the secondary item are changed by the server automatically in response to determining a change in the primary item.

Regarding claim 2, Henson shows soliciting and receiving by the server authorization from the shopper to change a corresponding attribute of the secondary item in response to the change in the attribute of the primary item; (see at leas col.8, lines 7- 55, "....... *The system option compatibility warning includes an icon, for example, in the form of a green check mark as shown in FIGS. 3 and 4. The system option compatibility warning icon is presented to the online shopper when a system option identified as having an incompatibility with another system option is recognized as a customer selection. .... Customers of the on-line store application thus receive advance warning when an option will not work for a given configuration. The customer can then modify, change, and/or delete the particular option which gave rise to the validation warning.* ".).

Regarding claims 3-4, Henson further teaches that said authorization is explicit (see at least col.8, line 62-col.9, line 8, " .... *Active validation is the active cross-checking of the options of a configuration and indicating the occurrence of a problem when the problem is detected. That is, upon the detection of the specific options within the same configuration, a warning can be provided to the customer. Alternatively, upon the selection of a first option, wherein the first option cannot exist with a second option within the same configuration, selection of the second option can be disabled. ....* ". Note: Active validation corresponds to the explicit authorization.) and implicit (see at least col.8, lines 56-62, " ..... *Passive validation relates to the validation module knowing that specific options don't work together, and providing a validation message that specific options should not be included in the same configuration.* ". Note: Passive validation corresponds to the implicit authorization.).

Regarding claim 14, Henson discloses that after said determining step has determined that the shopping command has changed the attribute of said primary item and before said identifying step, said method further comprising the steps of ascertaining whether the primary item is a new primary item; and after said ascertaining has ascertained that the primary item is not said new primary item, then performing said identifying step (see col.15, lines 31-45, " *Everything in the configurator is specific to a given computer system (i.e., chassis) per customer or per set of customers. The welcome page is geared towards identifying a chassis. Given the chassis, the configurator displays the universe or possible options within that chassis, for a given customer set. Messaging has now been included in that option universe to assist a user in choosing a best selection for that user. If a user decides upon a different chassis, the user must return to the welcome page and select another chassis. The options within the configurator are dependent upon the chassis. If a user wants to go to a different universe, then the user must exit the configurator, go back to the welcome page, and select a new universe (i.e., a different chassis). Recommendations can include lead time warnings, as well as compatibility warnings.* ".Note: In Henson the server ascertains if the computer system is different and then only displays the secondary items, that is options accordingly.

Regarding claim 15, Henson discloses that in the method of claim 1, wherein the attribute of the primary item and the corresponding attribute of the secondary item are a same attribute (see at least col.6, lines 44-67), which discloses the attribute of lead time/delivery and this attribute is same for both the computer system [the primary item] and the options [secondary items]0.

Regarding claim 16, Henson teaches that in the method of claim 1, wherein the attribute of the primary item and the corresponding attribute of the secondary item are different attributes (see at least Figs 3A and 3B wherein the attributes of the computer system, that is Dell Dimension XPS R, reference numbers "79"[primary item] in FIG.3A and Printer [secondary item] in Fig.3B have different attributes.

Regarding claim 17, Henson discloses that the method of claim 1, wherein the communication network comprises the Internet (see at least col.5, line 66-col.6, line 1, *"Turning now to FIG. 2, a customer can access the online store 10 using any suitable computer equipment 40, via the Internet 42."*).

Regarding claim 18, Henson teaches that in the method of claim 1, said determining, identifying, and changing steps being performed for a merchant of the primary item (see at least col.1, lines 18-21 and FIG.3A which teaches that the steps of determining, identifying, and changing are being done for a merchant, such as an online store for computers).

Regarding system claims 19-22 and 24-28, their limitations are closely parallel to the method claims 1-4 and 14-18 and are therefore analyzed and rejected on the basis of same rationale.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson and further in view of Chandramohan et al. (US Patent 6,711,619), hereinafter referred to Chandramohan.

Regarding claim 13, Henson teaches the method of claim 1 as analyzed above but does not disclose that before said determining step, said method further comprising the step of awaiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server. However, in the same field of cleint0server architecture, Chandramohan discloses the step of awaiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server (see at least col.7, line 27-col.8, line 12, " *FIG. 3A is a timing diagram that illustrates the method and operation of the present embodiment. As a background activity, the e-serve server module 101 monitors the network 146 (as shown in FIG. 1A) and waits for requests from e-serve client modules 103, as shown in element 306. ....".*). In view of Chandramohan, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have incorporated the feature of awaiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server because it is well-known that the Transmission Control Protocol/Internet Protocol (TCP/IP) is a common networking protocol used for communication among computer systems 100 that allows uniform formatting of data for transmittal and receipt and enabling the e-server to communicate with the client modules.

Regarding system claim 23, its limitations are closely parallel to the method claim 13 and is therefore analyzed and rejected on the basis of same rationale.

(11)   Response to Argument

Response to Arguments

A.   Ground of Rejection 1:

Claims 1, 17-19 and 27-28

a.   In response to applicant's argument (see page 7, lines 6-14) that "

deciding upon a different chassis" is ambiguous, and could mean that the user

has selected a different chassis in addition to an initially selected chassis, the

fact that applicant has recognized another advantage which would flow naturally

from following the suggestion of the prior art cannot be the basis for patentability

when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227

USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The examiner interprets the Henson's

disclosure (col.15, lines 31-45) as quite explicit in suggesting that at any time if

the user wants to change the computer system (chassis), that is the primary item

he can do so irrespective of the fact if it is an already selected or an additional

new item. Therefore, the said applicant's arguments are not found persuasive.

b.   In response to applicant's argument (see page 5, line 17-page 9, line 6)

that Henson does not disclose identifying by the server a secondary item in the

shopping cart linked to the primary item because the menu items presented to

the user are not in the user's shopping cart as required by claims 1 and 19, the

examiner would like to compare the systems and process used by the applicant's

invention and the prior art of Henson, as follows:

Fig.1 of the applicant's invention shows a system comprising an online shopper

100 interacting with an on-line merchant 130 via Internet 110 and this environment

matches with that of Henson, see Fig.2 , wherein on-line store "10" corresponds to the

on-line merchant 130 and which is accessed by an user using computer "40". In the

applicant's invention the server corresponding to the on-line merchant 130 uses the

shopping commands to assemble, that is configure a shopping cart 200 of items to be

purchased from the merchant and to execute any changes in the already selected items

or adding items. Similarly, in Henson the server of the on-line store 10, as detailed in

Fig.11 implements the shopping commands received from users for adding and making

changes in their selections via commerce application "14" and those shopping

commands are manifested via configurator and the shopping cart, which are

constituents of the "commerce application" 14. The configurator, see Henson col. 6,

lines 18-30, allows an user to customize a computer system with add-on options [the

computer system is the primary item and the add-on options are secondary items] and

upon obtaining a desired configuration the primary and secondary items are added on

to a cart. In Henson, commerce application 14 comprising the configurator and cart

teaches the step of determining by the server whether a shopping command of the

shopper has changed an attribute of a primary item in the shopping cart, after the server

has determined that the shopping command has changed an attribute of the primary

item in the shopping cart, identifying by the server a secondary item in the shopping cart

linked to the primary item, and changing by the server a corresponding attribute of the

secondary item in response to the change in the attribute of the primary item (see

col.15, lines 31-45 and col.3, lines 12-29 which teach that the configurator, which is part

of the commerce application 14, everything including the computer system [primary

item], its add-on options which correspond to the claimed secondary items is specific to

a given computer system [primary item] and therefore when a user wants to change the

computer system the configurator would change both the primary item and the add-on

options to the changed computer system. Whenever a user's shopping command is

received by the on-line store "10" its server allows the user to change the computer

system by allowing him to select a new primary system on the welcome page and then

presents the changed primary item, that is the computer system with its specific add-on

options [secondary items]. Changing the computer system requirement by the user

corresponds to the shopping command from the user for changing an attribute of the

primary item [the computer system which the user wants to buy]. Therefore, Henson

suggests that the attributes of the secondary item are changed by the server

automatically in response to determining a change in the primary item. For example,

Figs. 3A-3C demonstrate configuration for a primary item, that is a desk top computer

system model XPS R and if the user wants to change to another desktop Dell Model or

a Laptop computer the server on the on-line store 10 server will change the attributes of

the add-on options [secondary items] specific to the changed Dell desktop model or a

laptop computer system. The applicant discloses integrated software in the form of

shopping cart implementing the combined functions of the configurator and the cart in

Henson. The applicant's disclosure of integrated software in the form of shopping cart

instead of the structure disclosed in the prior art would be matter of obvious engineering

choice. See MPEP 2144.04 V B: Making Integral:

" In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to

a fluid transporting vehicle was rejected as obvious over a prior art reference which

differed from the prior art in claiming a brake drum integral with a clamping means,

whereas the brake disc and clamp of the prior art comprise several parts rigidly secured

together as a single unit. The court affirmed the rejection holding, among other reasons,

"that the use of a one piece construction instead of the structure disclosed in [the prior

art] would be merely a matter of obvious engineering choice."

In response to applicant's argument (page 8, line 21-page 9, line 6) that

Henson's server presents menu options to the user to change the attribute of a

secondary item by making a selection from the menu , the fact that applicant has

recognized another advantage which would flow naturally from following the suggestion

of the prior art cannot be the basis for patentability when the differences would

otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter.

1985). It is already analyzed above that the software, Commerce Application "14" in

Henson comprising configuration and a cart does change the attributes of the

secondary items to be specific to the changed primary item with the change in primary

item and the function or presenting menu of the secondary items further helps the on-

line store server to request authorization for the changed secondary items when the user indicates his authorization by selecting the secondary items as per his choice.

In view of the above analysis for claim 1, the rejection of claims 1, 17-19 and 27-28 is sustainable as submitted in the Final office action.

Claims 2-4 and 20-22:

In view of the above analysis for claim 1, the rejection of claims 2 and 20 is sustainable as submitted in the Final office action. The applicant further argues (see page 9, line 16-page 11, line 7) that Henson does not teach soliciting and receiving by the server authorization from the shopper to change the corresponding attribute of the secondary item in response to the change in the attribute of the primary item. The examiner respectfully disagrees. In Henson, as analyzed above, the function or presenting menu of the secondary items further helps the on-line store server to request authorization for the changed secondary items when the user indicates his authorization by selecting the secondary items as per his choice and if any of these secondary items, for any reason, do not correspond to the primary item the server would not validate the acceptance of that secondary item.

In view of the above, the rejection of claims 2-4 and 20-22 is sustainable as submitted in the Final office action. It is to be noted that the applicant's arguments for claims 3-4 and 21-22 are based on the same reasoning as presented for claims 2 and 20.

Claims 14 and 24:

In view of the above analysis for claim 1, the rejection of claims 2 and 20 is

sustainable as submitted in the Final office action. The applicant further argues (see

page 11, line 12-page 12, line 3) that Henson does not teach the feature of "

ascertaining whether the primary item is a new primary item; and after said ascertaining

has ascertained that the primary item is not said new primary item, then performing said

identifying step." The examiner disagrees. Because Henson's invention explicitly

teaches that the add-on options, that is secondary items, are presented to the user

specific to the computer system [the primary item] and if the primary item, that is the

computer system changes so will the attributes of the secondary item, as analyzed

above and also refer to col.3, lines 12-29 and col.15, lines 30-45. For example, if the

user changes the primary item, that is the computer system from Dell Dimension XPS R

to another dell series computer system the server of the on-line store 10 will ascertain

this change and will after ascertaining this change will identify the add-on options, that is

secondary items specific to the new series computer system and present them in the

configurator.

In view of the above, the rejection of claims 14 and 24 is sustainable as

submitted in the Final office action.

Claims 15 and 25 :

In view of the above analysis for claim 1, the rejection of claims 15 and 25 is

sustainable as submitted in the Final office action. The applicant further argues (see

page 12, lines 8-20) that Henson does not teach the feature of " wherein the attribute

of the primary item and the corresponding attribute of the secondary are a same

attribute." The examiner disagrees, because Henson's invention does teach that both

the primary item [the computer system] and the secondary items [add-on options]

have a long lead time warning and which is a common attribute for both the primary

and secondary item, see col.6, lines 44-67.

In view of the above, the rejection of claims 15 and 34 is sustainable as

submitted in the Final office action.

Claims 16 and 26

In view of the above analysis for claim 1, the rejection of claims 16 and 26 is

sustainable as submitted in the Final office action because the configurator combined

with the cart in Henson implements all the functions as claimed by the applicant's

claimed shopping cart.

B.   Ground of Rejection 2:

Claims 13 and 23 :

The applicant argues (see remarks, page 13, lines 8-21) that the reasons

provided by the examiner to modify Henson by combining with the teachings of

Chandramohan are not persuasive. The examiner respectfully disagrees. In response to

applicant's argument that the reasons provided by the examiner to modify Henson by

combining with the teachings of Chandramohan are not persuasive., the test for

obviousness is not whether the features of a secondary reference may be bodily

incorporated into the structure of the primary reference; nor is it that the claimed

invention must be expressly suggested in any one or all of the references. Rather, the

test is what the combined teachings of the references would have suggested to those of

ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Claim 13 recites " The method of claim 1, wherein before said determining step, said

method further comprising the step of : waiting by the server for said shopping

command and continuing to wait by the server for said shopping command so long as

said shopping command has not been received by the server. ". In claim 1 the

shopping command refers to changing an attribute of a primary item in the shopping art

and therefore it would be obvious that the server of online store 10 in Henson would

not initiate the step of determining if the shopping command has changed the attribute

of the primary item till the server receives such a command from the user. Henson also

teaches that the server on on-line store 10 changes the chassis, that is the computer

system which corresponds to the primary item only on receiving a request from the

consumer , see col.15, lines 31-45 and that implies that the server waits or will continue

to wait to receive a shopping command for changing the attributes of the primary item.

Since Henson does not explicitly state that the server waits for said shopping command

the examiner combined the teachings of Chandramohan that the e-server module 101

waits for the requests from client modules to initiate further steps in the process, see

col.7, line 27-col.28, line 12. The invention of Chandramohan is related to a method,

system and apparatus for distributing computer related services, such as computer-based applications over a network which teaches that the server responds to the inputs received from a user interface and is thus in the same field of endeavor that is of Henson which is related to providing services of selling computer and computer related items/services in response to the inputs received from a user and therefore in view of the teachings of Chandramohan, it would be obvious to one of an ordinary skill in the art to understand and imply the teachings that the server in Henson waits for a shopping command and continues to wait by for said shopping command so long as said shopping command has not been received by the server to initiate further step of presenting the new primary item along with new attributes of secondary item.

For the above reasons, it is believed that the rejections submitted in the Final office action should be sustained.

Respectfully submitted,

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9-12-05

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